AF/3622

ATTORNEY DOCKET NO. 2166CON2C

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT:	Steven M. Golden, et al.	)	
		)	
SERIAL NO.:	09/490,362	)	**Group No.** 3622
		)	
FILED:	January 24, 2000	)	**Examiner:** Raquel Alvarez
		)	
FOR:	INTERACTIVE MARKETING NETWORK AND PROCESS USING ELECTRONIC CERTIFICATES	)	

TRANSMITTAL OF APPEAL BRIEF
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES
UNDER 37 CFR 1.136(a) (Large Entity)

Assistant Commissioner of Patents
Washington, D.C. 20231

Sir:

Transmitted Herewith is a Transmittal of Appeal Brief to the Board of Patent Appeals and Interferences under the provisions of 37 CFR 1.136(a).

The fee for the Appeal Brief has been calculated as shown below:

Fee for Appeal Brief:	$330
TOTAL FEE FOR APPEAL BRIEF:	**$330**

☒ The commissioner is hereby authorized to charge any filing fees associated with this communication or credit any overpayment to our Deposit Account No. 14-1131.

☒ If an additional extension of time is required, please consider this a petition therefor and charge any additional fees which may be required to Deposit Account No. 14-1131. (A duplicate copy of this sheet is enclosed.)

This Transmittal of Appeal Brief to the Board of Patent Appeals and Interferences and under 37 CFR 1.136(a) is respectfully submitted by the undersigned:

Thomas G. Scavone
Registration No. 26,801
NIRO, SCAVONE, HALLER & NIRO
181 West Madison Street - Suite 4600
Chicago, Illinois 60602
(312) 236-0733

Dated: September 1, 2004

I certify that this document and enclosed fee is being deposited on September 1, 2004 with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Assistant Commissioner for Patents, Washington DC 20231

Carol Koski

Signature of Person Mailing Correspondence

Carol Koski

Typed or Printed Name of Person Mailing Correspondence

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPLICANT:	Steven M. Golden, et al.	)	
SERIAL NO.:	09/490,362	)	Group No. 3622
FILED:	January 24, 2000	)	Examiner: Raquel Alvarez
FOR:	INTERACTIVE MARKETING NETWORK AND PROCESS USING ELECTRONIC CERTIFICATES	)	Attorney Docket No. 2166CON2C

BRIEF ON APPEAL

Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

INTRODUCTION

This appeal is taken from the final rejection of all claims pending in this application, Claims 61-63 (See Appendix, Exhibit A).

The Notice of Appeal to the Board of Patent Appeals and Interferences was timely filed by first class mail sent on June 29, 2004, and received in the PTO on July 2, 2004 (See Appendix, Exhibit B). This Appeal Brief is therefore timely filed on or before September 2, 2004. An oral hearing of this appeal is respectfully requested.

1. REAL PARTY IN INTEREST

The real party in interest is the Appellant and Patent Application Owner(s),Coolsavings, Inc.

2. RELATED APPEALS AND INTERFERENCES

None.

3. STATUS OF CLAIMS

The application was originally filed with Claims 1-19. Claims 1-19 were cancelled in Appellant's Preliminary Rule 115 Amendment of August 2, 2000 in favor of new Claims 20-60. Claims 20-60 were cancelled by Appellant's amendment of October 9, 2003 in favor of new Claims 61-63. This appeal is taken with respect to Claims 61-63 which are pending and have been finally rejected. Claim 61 is the only independent claim pending in this appeal.

4. STATUS OF AMENDMENTS

No amendments have been filed subsequent to the Examiner's final rejection on December 31, 2003.

5. SUMMARY OF INVENTION

The present invention is directed to a process for distributing and redeeming coupons. The process comprises the following steps, recited in Claim 61:

> establishing electrical communication over the Internet between a service system and a plurality of remote users having personal computers;
>
> receiving at the service system from a plurality of issuer systems instructions for issuing the redeemable coupons;

receiving at the service system profile data input by the remote users over the Internet;

the service system permitting remote user access to offers for redeemable coupons upon the entry of profile data requested of the remote users by the service system;

said offers being accessible over the Internet to selective remote users based on analysis of the profile data;

storing coupon files in a data base, said coupon files containing information relating to redeemable coupons offered to and selected by the remote user; and

automatically redeeming coupons contained in said stored data base when the remote users make transactions using a credit card.

In summary, the present invention is directed to a coupon distribution and redemption process wherein the coupons are not only targeted based upon presubmitted profile data, but also the coupons are automatically redeemed by the remote users when the purchase transaction is completed using a credit card. The invention requires more than merely presenting a credit card for identification; rather, the invention describes a process whereby an earlier selected coupon is automatically redeemed when the

customer purchases the product specified in the coupon through use of a credit card.

6. ISSUES

The individual issues for resolution in this appeal are:

(1) Whether Claims 61-63 are unpatentable under 35 U.S.C. § 103(a) as obvious over Barnett (6,336,099) in view of Bezos (5,715,399).

(2) Whether Claims 61-63 are unpatentable under the judicially created doctrine of obviousness-type double patenting as not patentably distinct over U.S. Patent No. 5,761,648 in view of Barnett (6,336,099) and Bezos (5,715,399).

(3) Whether Claims 61-63 are unpatentable under the judicially created doctrine of obviousness-type double patenting as not patentably distinct over U.S. Patent No. 10/438,582 in view of Barnett (6,336,099) and Bezos (5,715,399).

7. GROUPING OF CLAIMS

Appellant states that the claims recited in issues 1, 2 and 3 stand or fall together.

8. ARGUMENT

I. Introduction

All of the grounds for rejection cited above (see Issues 1-3 in Section 6) rely in part on the Examiner's rejection of independent Claim 61 under 35 U.S.C. § 103(a) as obvious over

Barnett (6,336,099) in view of Bezos (5,715,399). Since the Examiner's rejection of the dependent claims listed in issues 1-3 relies on the rejection of independent Claim 61, Appellant's initial argument focuses on this prior art.

II. The Legal Standard for Obviousness

The PTO has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. In re Thrift, 298 F.3d 1357, 1363, 63 U.S.P.Q.2d 2002, 2006 (Fed. Cir. 2002); In re Glaug, 283 F.3d 1335, 1338, 62 U.S.P.Q.2d 1151, 1152 (Fed. Cir. 2002); In re Fine, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); In re Piasecki, 745 F.2d 1468, 1471-72, 223 U.S.P.Q. 785, 787-88 (Fed. Cir. 1984). In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. In re Rouffet, 149 F.3d 1350, 1355, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998); In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Brouwer, 77 F.3d 422, 425, 37 U.S.P.Q.2d 1663, 1666 (Fed. Cir. 1996)("when the references cited by the examiner fail to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned").

To establish a *prima facie* case of obviousness, the prior art references relied upon, when combined, must teach or suggest all the claim limitations of the invention. In re Royka, 490 F.2d 981,

984, 180 U.S.P.Q. 580, 582 (CCPA 1974). Ascertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art references as a whole. In re Brouwer, 77 F.3d 422, 425, 37 U.S.P.Q.2d 1663, 1666 (Fed. Cir. 1996). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494 (CCPA 1970). During examination, the claims must be interpreted as broadly as their terms reasonably allow. In re Zletz, 893 F.2d 319, 321-322, 13 U.S.P.Q.2d 1320, 1322 (Fed. Cir. 1989); In re Heck, 699 F.2d 1331, 1332, 216 U.S.P.Q. 1038, 1039 (Fed. Cir. 1983); In re Pearson, 494 F.2d 1399, 1404, 181 U.S.P.Q. 641, 645 (CCPA 1974). Thus, the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. Zletz, 893 F.2d at 321-22; See, In re Baker Hughes, Inc., 215 F.3d 1297, 55 U.S.P.Q.2d 1149 (Fed. Cir. 2000)(reversing the Board's *prima facie* obviousness rejection where the Board erred in construing certain claim terms).

In addition to the requirement that each and every claim limitation be taught or suggested by the prior art, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. In re

Jones, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1943-44 (Fed. Cir. 1992); In re Fine, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598-99 (Fed. Cir. 1988). The mere fact that the prior art could be so modified does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Mills, 916 F.2d 680, 682, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990); In re Gordon, 733 F.2d 900, 903, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984); See, In re Rouffet, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998) (reversing the Board's *prima facie* obviousness rejection where, although the combination of the references taught every element of the claimed invention, the references were without a motivation to combine). The teaching or suggestion to make the claimed combination must be found in the prior art, not in the applicant's disclosure. In re Vaeck, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); In re Dow Chemical Co., 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

If an independent claim is found to be nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is also nonobvious. In re Fine, 837 F.2d 1071, 1076, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988); In re Royka, 490 F.2d 981, 984, 180 U.S.P.Q. 580, 582 (CCPA 1974).

The Appellant contends that the Examiner has failed to meet her burden of establishing a *prima facie* case of obviousness under

35 U.S.C. § 103 in this matter. Each and every claim limitation of independent Claim 61 of the present invention is neither taught nor suggested by the combination of the Barnett (6,336,099) and Bezos (5,715,399) references cited by the Examiner as the basis for rejection. When the language of Claim 61 is properly construed, there is no evidence to demonstrate a suggestion or motivation to combine the Barnett and Bezos references in such a way that would result in the present invention. As such, the Examiner has failed to meet her burden of establishing a *prima facie* case of obviousness, and the obviousness rejection should properly be withdrawn.

III. Issue No.1: Claims 61-63 are Patentably Distinct from the References Cited by the Examiner as a Basis for Rejection Under 35 U.S.C. § 103(a)

The Examiner's final rejection of Claim 61 relies on the combination of Barnett (6,336,099) with Bezos (5,715,399) (See Appendix, Exhibit C for prior art references). The Appellant disagrees with the Examiner that Barnett and Bezos, when combined, teach or suggest each and every claim limitation of Claim 61. More specifically, the Appellant contends that Barnett and Bezos fail to teach or suggest the final limitation of Claim 61, which states:

> "automatically redeeming coupons contained in said stored data base when the remote users make transactions using a credit card."

In rejecting Claim 61, the Examiner stated,

> "With respect to automatically redeeming coupons contained in said stored data base when the remote users make transactions using a credit card, Barnett teaches allowing the users to redeem the stored coupons when making purchases *electronically/automatically* (see figure 1 and col. 11, lines 30-40)."

(emphasis added)(Appendix, Exhibit D, Paper No. 11 at pg. 4-5). The portion of the Barnett specification to which the Examiner refers, however, specifically recites,

> "Thus, the printable coupon data generation routine 32d combines all this information and generates a record indicative of the unique coupon to be printed. This record is temporarily stored in the output buffer 28, where it is subsequently sent to the printer 8 for printing. In the alternative, the coupon may be redeemed *electronically* by sending the coupon data in the output buffer via the data communications interface 20 back to the online service provider 2. This is especially useful in the "electronic shopping mall" environment now found in many online services. The electronic coupon data could also be routed via the data communications interface 20 to a retail store where the user will be shopping, where the coupon data is held in a buffer pending purchase by the user of the matching product."

(emphasis added)(Appendix, Exhibit C, Barnett, col. 11, lines 30-40). While the Appellant agrees that Barnett teaches a method of redeeming coupons electronically, Barnett fails to disclose the specific process of automatic coupon redemption described in Claim 61 of the present application. There is a novel and nonobvious difference between "electronically redeeming coupons" as disclosed by Barnett and "automatically redeeming coupons" as claimed by the present invention which renders the two inventions patentably

distinct.

The plain and ordinary meaning of the word "automatically" does not in any way suggest that the word is synonymous with "electronically." Quite to the contrary, the plain and ordinary meaning of "automatically" is synonymous with terms such as "unprompted" and "involuntary." (See Appendix, Exhibit E, Thesaurus definition of "automatic"). The word "automatically" is defined as:

> "(1)(a): largely or wholly involuntary; (b): acting or done spontaneously or unconsciously; (c): done or produced as if by machine: mechanical; (2): having a self-acting or self-regulating mechanism; (3) of a firearm: using either gas pressure or force of recoil and mechanical spring action for repeatedly ejecting the empty cartridge shell, introducing a new cartridge, and firing it."

(See Exhibit E, Dictionary definition of "automatically"). In comparison to the above recited definition of "automatically," the word "electronically" is defined as:

> "(1): of or relating to electrons; (2): of, relating to, or utilizing devices constructed or working by the methods or principles of electronics; also: implemented on or by means of a computer; (3)(a) generating musical tones by electronic means; (b): of, relating to, or being music that consists of sounds electronically generated or modified; (4): of, relating to, or being a medium by which information is transmitted electronically."

(See Exhibit E, Dictionary definition of "electronically").

Perhaps the most important difference between the terms "automatically" and "electronically" is that the term

"automatically" invokes a sense of time. Recognizing this difference is the key to understanding the distinctness of the invention claimed by Barnett and the invention represented by the present application in Claim 61. For example, consider the use of common phrases such as "automatic firearm" or "automatic transmission" versus other common phrases such as "electronic banking" or "electronic ticket." The operation of the items incorporating the term "automatic" takes place independently and immediately subsequent to a relevant externally influenced act. These items posses a self-acting or self-regulating quality that occurs on a largely or wholly involuntary basis. In contrast, the phrases incorporating the term "electronic" do not inherently involve an independent immediate action flowing from a user's external act.

Even the drafter of Barnett himself presumably appreciated the difference in the use of the terms "automatically" and "electronically." For example, Barnett recites,

> "Certain coupon data may be *automatically* deleted from the user's computer after, e.g., one month, notwithstanding that the coupon, if printed, might have an expiration date in six months. This feature is included to prompt users who know of the *time-sensitive autodeletion* to promptly print (and use) coupons rather than risk having them deleted from their database."

(emphasis added) (Appendix, Exhibit C, Barnett, col. 12, lines 2-8). Barnett also states,

> "If a particular function button 52, 54, 56, or 58 chosen by the user initiates a routine 32 which requires online communication, *that routine will initiate, control and terminate* an online session with the service provider 2 *automatically.*"

(emphasis added)(Appendix, Exhibit C, Barnett, col. 9, lines 29-33). Each of these excerpts from Barnett demonstrates that the drafter understood the use of the word "automatically" to be different from the use of the word "electronically." Barnett uses the term "automatically" when referring to processes which are wholly involuntary and performed spontaneously (i.e., self-acting). The same cannot be said with respect to Barnett's use of the word "electronically." As one example, Barnett recites "the electronic distribution system of the preferred embodiment comprises a central located repository of electronically stored coupon data." (Appendix, Exhibit C, Barnett, col. 6, lines 30-32). The use of the term "electronically" therein quite obviously has no relation to any form of an automated time-sensitive process of any sort.

The terms "automatically" and "electronically" are clearly not interchangeable in the context of the Barnett reference. As such, it is improper for the Examiner in this case to use these terms interchangeably, or for that matter, to read the term "automatically" into the specific language used in Barnett when referring to coupon redemption, which is "electronically." Quite simply stated, Barnett does not disclose automatic coupon

redemption of the type disclosed by the present application. The electronic redemption described in Barnett does not have such an effect.

The Appellant agrees with the Examiner that Bezos teaches "a method and system for communicating a credit card number over a network." (Appendix, Exhibit D, Paper No. 11 at pg. 5) The Appellant further agrees with the Examiner that Bezos teaches that "a credit card facilitates making purchases via telephone or over a network." (Appendix, Exhibit D, Paper No. 11 at pg. 5) However, even when the teachings of Bezos are combined with those of Barnett, the invention of the present application remains nonobvious.

The combination of the Barnett and Bezos references fails to teach or suggest a process for automatically redeeming coupons as disclosed by the present invention. Furthermore, there is no suggestion of the desirability to combine Bezos with Barnett. The mere fact that Barnett could be modified by the teachings of Bezos does not make the modification obvious. As such, it is improper for the Examiner to combine these references in forming a rejection under 35 U.S.C. § 103. See, In re Rouffet, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998)(reversing the Board's *prima facie* obviousness rejection where, although the combination of the references taught every element of the claimed invention, the

references were without a motivation to combine).

In this case, the Examiner has improperly construed Appellant's use of the term "automatically" as recited in Claim 61. When the term "automatically" is properly construed, each and every claim limitation of Claim 61 of the present invention is neither taught nor suggested by the combination of the Barnett (6,336,099) and Bezos (5,715,399) references cited by the Examiner as the basis for rejection. As such, the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 in this matter. See, In re Baker Hughes, Inc., 215 F.3d 1297, 55 U.S.P.Q.2d 1149 (Fed. Cir. 2000)(reversing the Board's *prima facie* obviousness rejection where the Board erred in construing certain claim terms). Therefore, the obviousness rejection made by the Examiner under 35 U.S.C. § 103 should be withdrawn.

Claims 62 and 63 depend from Claim 61. If, as Appellant contends, the Barnett and Bezos references do not render Claim 61 obvious, for the same reasons set forth above the prior art identified by the Examiner does not render Claims 62 and 63 obvious either. See, In re Fine, 837 F.2d 1071, 1076, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988); See also, In re Royka, 490 F.2d 981, 984, 180 U.S.P.Q. 580, 582 (CCPA 1974). Accordingly, Claims 62 and 63 are also in condition for allowance over the cited prior art.

IV. Issue No. 2: Appellant's Agreed to Terminal Disclaimer with Respect to Claims 61-63 Satisfies the Double Patenting Rejection Based on U.S. Patent No. 5,761,648

The Examiner's final rejection of Claims 61-63 relies in part on the judicially created doctrine of obviousness-type double patenting. The Examiner found that the claims at issue were not patentably distinct over U.S. Patent No. 5,761,648 in view of Barnett (6,336,099) and Bezos (5,715,399). Appellant has previously agreed to provide an appropriate terminal disclaimer, upon notification of allowable subject matter, to overcome the double patenting rejection concerning U.S. Patent No. 5,761,648. As the Examiner stated in her final rejection of the claims at issue, "Applicant has agreed to provide a terminal disclaimer *therefore no further comment is necessary.*" (emphasis added) (See Appendix, Exhibit D, Paper No. 11 at pg. 5) As such, Appellant awaits the notification of allowable subject matter in the present application to thereafter provide an appropriate terminal disclaimer.

V. Issue No. 3: The Examiner Should Properly Withdraw the Double Patenting Rejection on Claims 61-63 with Respect to U.S. Patent No. 10/438,582

The Examiner's final rejection of Claims 61-63 relies in part on the judicially created doctrine of obviousness-type double patenting. The Examiner found that the claims at issue were not patentably distinct over U.S. Patent No. 10/438,582 ("the '582

application") in view of Barnett (6,336,099) and Bezos (5,715,399). Following the procedure stated in the MPEP § 804, if the "provisional" double patenting rejections in both applications are the only rejections remaining in those applications, the examiner should then withdraw the rejection in one of the applications and permit the application to issue as a patent. The examiner should maintain the double patenting rejection in the other application as a "provisional" double patenting rejection which will be converted into a double patenting rejection when the one application issues as a patent.

If, as Appellant contends, the Barnett and Bezos references do not render Claims 61-63 of the present application obvious under 35 U.S.C. § 103 for the reasons set forth above (see Section 8.(III.) above), the only remaining rejection in the present application is the "provisional" double patenting rejection. As such, Appellant requests that the Examiner properly withdraw the "provisional" double patenting rejection from the present application and permit the application to issue as a patent. The Examiner should maintain the double patenting rejection in the '582 application as a "provisional" double patenting rejection which will be converted into a double patenting rejection upon the present application issuing as a patent. Appellant thereafter would agree to provide a terminal disclaimer with respect to the '582 application, if

appropriate, upon notification of allowable subject matter for that application. Appellant reserves the right to argue patentable differences between the '582 application and any patent that may issue from the present application.

VI. Conclusion

The Appellant respectfully submits that the Barnett and Bezos references fail to make the claimed invention obvious in light of the proper meaning of the claim term "automatically." When the term "automatically" is properly construed, each and every claim limitation of independent Claim 61 of the present invention is neither taught nor suggested by the combination of the Barnett and Bezos references. Furthermore, when the language of Claim 61 is properly construed, there is no evidence to demonstrate a suggestion or motivation to combine the Barnett and Bezos references in such a way that would result in the present invention. As such, the Examiner has failed to meet her burden of establishing a *prima facie* case of obviousness. For the reasons stated above, Appellant respectfully contends that the Examiner's rejection of Claims 61-63 under 35 U.S.C. § 103(a) in view of the Barnett and Bezos references should be withdrawn, and Appellant's Claims 61-63 be found allowable.

Appellant has previously agreed to file an appropriate terminal disclaimer on the present application with respect to the

'648 patent upon notification of allowable subject matter. Appellant further submits that the Examiner's rejection of Claims 61-63 for double patenting in light of the '582 application must properly be withdrawn in accordance with MPEP § 804, thereby placing Claims 61-63 of the present application in condition for allowance.

Respectfully submitted,

Thomas G. Scavone (Reg. No. 26, 801)
NIRO, SCAVONE, HALLER & NIRO
181 West Madison Street - Suite 4600
Chicago, Illinois 60602
(312) 236-0733

Attorneys for Appellant

Dated: September 1, 2004

9. APPENDIX

Exhibit	Description
A	Claims 61 through 63 of U.S. Patent No. 09/490,362
B	Notice of Appeal with return post card stamped received by PTO, July 2, 2004
C	U.S. Patent Nos. 6,336,099 (Barnett) and 5,715,399 (Bezos)
D	Office Action dated December 31, 2003
E	Definitions from Merriam-Webster Online Dictionary and Thesaurus (accessable at www.webster.com)

EXHIBIT A

Claims 61-63 of U.S. Patent No. 09/490,362

Claim 61: A process for distributing and redeeming coupons, comprising the steps of:

establishing electrical communication over the Internet between a service system and a plurality of remote users having personal computers;

receiving at the service system from a plurality of issuer systems instructions for issuing the redeemable coupons;

receiving at the service system profile data input by the remote users over the Internet;

the service system permitting remote user access to offers for redeemable coupons upon the entry of profile data requested of the remote users by the service system;

said offers being accessible over the Internet to selective remote users based on analysis of the profile data;

storing coupon files in a data base, said coupon files containing information relating to redeemable coupons offered to and selected by the remote user; and

automatically redeeming coupons contained in said stored data base when the remote users make transactions using a credit card.

Claim 62: The process for distributing and redeeming coupons

as set forth in Claim 61 wherein said coupon file is transmitted to said data base using the Internet.

Claim 63: The process for distributing and redeeming coupons as set forth in Claim 61 wherein said coupon file is transmitted to said data base via the service system using the Internet.

Applicant: Steven M. Golden, et al
Serial No.: 09/490,362
Filing Date: January 24, 2000
For: Interactive Marketing Network &
Process Using Electronic Certificates

Notice of Appeal including:
- Statement of Substance of Interview
- Request for oral hearing
- Authorization to charge acctg 14-1131

2166CON2C 29 June 2004

ATTORNEY
DOCKET NO 2166CON2C

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPLICANT:	Steven M. Golden, et al	)	
		)	
SERIAL NO.:	09/490,362	)	**Group No.** 3622
		)	
FILED:	January 24, 2000	)	**Examiner:** R. Alvarez
		)	
FOR:	INTERACTIVE MARKETING NETWORK AND PROCESS USING ELECTRONIC CERTIFICATES		

Assistant Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Notice of Appeal and Request for Oral Hearing

Sir:

Applicant(s) hereby appeal to the Board of Patent Appeals and Interferences from the decision of the Primary Examiner dated December 31, 2003 Finally rejecting Claim(s) 61-63. **A Request for a three month extension of time from March 31, 2004 to June 30, 2004 is hereby requested.**

Applicant also requests an oral hearing before the Board of Patent Appeals and Interferences in the appeal of the above-identified application.

FEE FOR NOTICE OF APPEAL :	**$330.00**
FEE FOR REQUEST FOR ORAL HEARING	**$290.00**
FEE FOR REQUEST FOR A THREE MONTH EXTENSION OF TIME:	**$950.00**
TOTAL:	**$1570.00**

☒ The commissioner is hereby authorized to charge the fee for the Notice of Appeal, Request for Oral Hearing and Request for Three Month Extension to our Deposit Account No. 14-1131.

☒ The commissioner is hereby authorized to charge any additional filing fees associated with this communication to our Deposit Account No. 14-1131.

I certify that this document and enclosed fee is being deposited on June 29, 2004 with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Assistant Commissioner for Patents, Washington DC 20231

Signature of Person Mailing Correspondence

Hannah Martin

Typed or Printed Name of Person Mailing Correspondence

Respectfully submitted,

Thomas C. Scavone
Registration No. - 26,801
NIRO, SCAVONE, HALLER & NIRO
181 West Madison Street - Suite 4600
Chicago, Illinois 60602
(312) 236-0733
Date: June 29, 2004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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FOR:	INTERACTIVE MARKETING NETWORK AND PROCESS USING ELECTRONIC CERTIFICATES	)	Attorney Docket No. 2166CON2C

STATEMENT OF SUBSTANCE OF INTERVIEW

Applicants hereby respond to the Interview Summary issued by the Examiner on June 16, 2004.

A telephone interview was conducted by the undersigned attorney and Examiner Alvarez on June 15, 2004. The language "automatically redeeming coupons...using a credit card" in claim 61 was discussed. Applicants explained that, in their view, the Barnett reference does not teach or disclose this limitation. The Examiner did not agree. The Examiner's reasons are stated in the June 16, 2004 Interview Summary Form.

Thomas G. Scavone
Reg. No. 26,801
NIRO, SCAVONE, HALLER & NIRO
181 West Madison Street - Suite 4600
Chicago, Illinois 60602
(312) 236-0733

Attorneys for Applicants

Dated: June 29, 2004

PTO/SB/32 (06-04)
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REQUEST FOR ORAL HEARING BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Docket Number (Optional): 2166CON2C

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]
on June 29, 2004

Signature _____

Typed or printed name Hannah Martin

In re Application of
Steven M. Golden, et al

Application Number	Filed
09/490,362	January 24, 2000

For Interactive Marketing network & process using ....

Art Unit	Examiner
3622	R. Alvarez

Applicant hereby requests an oral hearing before the Board of Patent Appeals and Interferences in the appeal of the above-identified application.

The fee for this Request for Oral Hearing is (37 CFR 1.17(d)) $ 290.00

☐ Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by half, and the resulting fee is: $ _____

☐ A check in the amount of the fee is enclosed.

☐ Payment by credit card. Form PTO-2038 is attached.

☑ The Director has already been authorized to charge fees in this application to a Deposit Account. I have enclosed a duplicate copy of this sheet.

☑ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 14-1131 . I have enclosed a duplicate copy of this sheet.

☑ A petition for an extension of time under 37 CFR 1.136(b) (PTO/SB/23) is enclosed. For extensions of time in reexamination proceedings, see 37 CFR 1.550.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☑ attorney or agent of record. Registration number 26,801

☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____

Signature

Thomas G. Scavone
Typed or printed name

(312) 236-0733
Telephone number

June 29, 2004
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☑ *Total of 2 forms are submitted.

This collection of information is required by 37 CFR 1.194(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/490,362	01/24/2000	Steven M. Golden	2166	7063

7590 12/31/2003

Michael P. Mazza
Niro, Scavone, Haller & Niro
181 W. Madison
Suite 4600
Chicago, IL 60602

EXAMINER	
ALVAREZ, RAQUEL	

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 12/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/490,362	GOLDEN ET AL.	
	Examiner	Art Unit	
	Raquel Alvarez	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10/14/2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *61-63* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *61-63* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *6*.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

Notice of References Cited	Application/Control No. 09/490,362	Applicant(s)/Patent Under Reexamination GOLDEN ET AL.	
	Examiner Raquel Alvarez	Art Unit 3622	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-5,715,399	02-1998	Bezos, Jeffrey P.	705/27
	B	US-			
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

FORM PTO-1449
INFORMATION DISCLOSURE CITATION

Applicant: Golden et al.	Group: 3624 - Examiner James Bergin
Re: Reexamination of US Patent No. 5,761,648	
1st Control No: 90/005,641 Granted: February 18, 2000	2nd Control No: 90/005,773 Granted: July 17, 2000

U.S. PATENT DOCUMENTS

Examiner Initial		Document Number	Date	Name	Class	Subclass	Filing Date
R.A.	AA	4,672,377	06/09/1987	Murphy et al.	340	5.41	
R.A.	AB	4,673,802	06/16/1987	Ohmae et al.	705	17	
R.A.	AC	4,747,050	05/24/1988	Brachtl et al.	705	708	
R.A.	AD	4,855,908	08/08/1989	Shimoda et al.	705	20	
R.A.	AE	4,862,350	08/29/1989	Orr et al.	709	213	
R.A.	AF	5,025,372	06/18/1991	Burton et al.	705	14	
R.A.	AG	5,208,742	05/04/1993	Warn	700	2	
R.A.	AH	5,253,345	10/12/1993	Fernandes et al.	705	17	
R.A.	AI	5,297,026	03/22/1994	Hoffman	705	14	
R.A.	AJ	5,388,165	02/07/1995	Deaton et al.	382	139	
R.A.	AK	5,513,102	04/30/1996	Auriemma	705	14	

FOREIGN PATENT DOCUMENTS

Examiner Initial		Document Number	Date	Country	Class	Subclass	Translation
R.A.	AL	WO 93/15466	5 Aug 1993	PCT			[ ] Yes [ ] No
R.A.	AM	WO 94/27231	24 Nov 1994	PCT			[ ] Yes [ ] No
R.A.	AN	WO 95/16971	22 Jun 1995	PCT			[ ] Yes [ ] No
R.A.	AO	WO 97/23838	03 Jul 1997	PCT			[ ] Yes [ ] No
R.A.	AP	WO 97/31322	28 Aug 1997	PCT			[ ] Yes [ ] No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

R.A.	AR	9/19/1999 Memorandum Re: Phase 1 Functional Requirements for Catalina Online
R.A.	AS	Nikkei Multimedia for Business SEPTEMBER 1998 No. 38 (Japanese Publication - no translation available)
R.A.	AT	Nekkei Multimedia for Business MARCH 1998 No. 32 (Japanese Publication - no translation available)

Examiner: Raquel Alvarez **Date Considered:** 12/16/03

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP; Draw line through citation if not in conformance and not considered.

FORM PTO-1449
INFORMATION DISCLOSURE CITATION

Applicant: Golden et al.	Group: 3624 - Examiner James Bergin
Re: Reexamination of US Patent No. 5,761,648	
1st Control No: 90/005,641 Granted: February 18, 2000	2nd Control No: 90/005,773 Granted: July 17, 2000

U.S. PATENT DOCUMENTS

Examiner Initial		Document Number	Date	Name	Class	Subclass	Filing Date
L.A	BA	5,515,270	05/07/1996	Weinblatt	705	14	
L.A	BB	5,537,314	07/16/1996	Kanter	705	14	
L.A	BC	5,721,908	02/24/1998	Lagarde et al.	707	10	
L.A	BD	5,806,045	09/08/1998	Biorge et al.	705	14	
L.A	BE	5,859,414	01/12/1999	Grimes et. al	235	383	
L.A	BF	5,864,825	01/26/1999	Kobayashi et al.	705	24	
L.A	BG	5,870,723	02/09/1999	Pare, Jr. et al.	705	39	
L.A	BH	5,918,014	01/29/1999	Robinson	709	219	
L.A	BI	5,923,552	07/13/1999	Brown et al.	700	100	
L.A	BJ	5,970,472	10/19/1999	Allsop et al.	705	26	
L.A	BK	5,982,891	11/09/1999	Ginter et al.	705	54	

FOREIGN PATENT DOCUMENTS

Examiner Initial		Document Number	Date	Country	Class	Subclass	Translation
L.A	BL	WO 98/18093	30 Apr 1998	PCT			[ ] Yes [ ] No
L.A	BM	EP0512509A2	11 Nov 1992	Europe			[ ] Yes [ ] No
L.A	BN	EP0822535A2	04 Feb 1998	Europe			[ ] Yes [ ] No
L.A	BO	7-306654	11/21/1995	Japan (Translation of Abstract)			[ ] Yes [x] No
L.A	BP	8-115361	05/07/1996	Japan (Translation of Abstract)			[ ] Yes [x] No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	BR	
	BS	
	BT	

Examiner: Raquel Alvarez Date Considered: 12/16/03

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP; Draw line through citation if not in conformance and not considered.

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FORM PTO-1449
INFORMATION DISCLOSURE CITATION

Applicant: Golden et al.	Group: 3624 - Examiner James Bergin
Re: Reexamination of US Patent No. 5,761,648	
1st Control No: 90/005,641 Granted: February 18, 2000	2nd Control No: 90/005,773 Granted: July 17, 2000

U.S. PATENT DOCUMENTS

Examiner Initial		Document Number	Date	Name	Class	Subclass	Filing Date
L.A	CA	5,982,892	11/09/1999	Hicks et al.	514	300	
L.A	CB	5,987,504	11/16/1999	Toga	709	206	
L.A	CC	5,992,888	11/30/1999	North et al.	283	56	
L.A	CD	5,995,015	11/30/1999	DeTemple et al.	340	825.49	
L.A	CE	5,999,912	12/07/1999	Wodarz et al.	705	14	
L.A	CF	5,999,914	12/07/1999	Blinn et al.	705	26	
L.A	CG	6,009,410	12/28/1999	LeMole et al.	705	14	
L.A	CH	6,012,039	01/04/2000	Hoffman et al.	705	14	
L.A	CI	6,026,369	02/15/2000	Capek	705	14	
L.A	CJ	6,029,142	02/22/2000	Hill	705	27	
L.A	CK	6,047,263	04/04/2000	Goodwin, III	705	20	

FOREIGN PATENT DOCUMENTS

Examiner Initial		Document Number	Date	Country	Class	Subclass	Translation
L.A	CL	9-231263	09/05/1997	Japan (Translation of Abstract)			[ ] Yes [x] No
L.A	CM	10-143563	05/29/1998	Japan (Translation of Abstract)			[ ] Yes [x] No
L.A	CN	10-187320	07/14/1998	Japan (Translation of Abstract)			[ ] Yes [x] No
	CO						[ ] Yes [ ] No
	CP						[ ] Yes [ ] No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	CR	
	CS	
	CT	

Examiner: Raquel Alvarez Date Considered: 12/10/03

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP; Draw line through citation if not in conformance and not considered.

FORM PTO-1449
INFORMATION DISCLOSURE CITATION

Applicant: Golden et al.	Group: 3624 - Examiner James Bergin
Re: Reexamination of US Patent No. 5,761,648	
1st Control No: 90/005,641 Granted: February 18, 2000	2nd Control No: 90/005,773 Granted: July 17, 2000

U.S. PATENT DOCUMENTS

Examiner Initial		Document Number	Date	Name	Class	Subclass	Filing Date
R.A.	DA	6,076,068	01/13/2000	DeLapa et al.	705	14	
R.A.	DB	6,105,002	08/15/2000	Powell	705	14	
R.A.	DC	6,237,145 B1	05/22/2001	Narasimhan et al.	725	23	
R.A.	DD	6,321,208 B1	11/20/2001	Barnett et al.	705	14	
R.A.	DE	6,336,099 B1	01/01/2002	Barnett et al.	705	14	
	DF						
	DG						
	DH						
	DI						
	DJ						
	DK						

FOREIGN PATENT DOCUMENTS

Examiner Initial		Document Number	Date	Country	Class	Subclass	Translation
	DL						[ ] Yes [ ] No
	DM						[ ] Yes [ ] No
	DN						[ ] Yes [ ] No
	DO						[ ] Yes [ ] No
	DP						[ ] Yes [ ] No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	DR		
	DS		
	DT		

Examiner: Raquel Alexander Date Considered: 12/10/2003

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP; Draw line through citation if not in conformance and not considered.

DETAILED ACTION

1. This office action is in response to communication filed on 10/14/2003.

2. Claims 1-60 have been canceled. Claims 61-63 are presented for examination.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 61-63 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 5,761,648 in view of Barnett (6,336,099 hereinafter Barnett) and Bezos (5,715,399 hereinafter Bezos). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application further recites automatically redeeming coupons contained in said stored data base when the remote users make transaction using a credit card. Barnett teaches allowing the users to redeem the stored coupons when making purchases electronically/automatically (see figure 1 and col. 11, lines 30-40). Barnett is silent as to the form of payment used to make the purchases. Bezos teaches a method and system for communicating a credit

card number over a network. The customer/user makes an on-line purchase using one or more credit cards (col. 5, lines 24-38) . It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included using a credit card to make the purchases because **a credit card facilitates making purchases via telephone or over the network** (in Bezos col. 1, lines 41-42).

4. Claims 61-63 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 10/438,582 in view of Barnett and Bezos. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application further recites automatically redeeming coupons contained in said stored data base when the remote users make transaction using a credit card. Barnett teaches allowing the users to redeem the stored coupons when making purchases electronically/automatically (see figure 1 and col. 11, lines 30-40). Barnett is silent as to the form of payment used to make the purchases. Bezos teaches a method and system for communicating a credit card number over a network. The customer/user makes an on-line purchase using one or more credit cards (col. 5, lines 24-38) . It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included using a credit card to make the purchases because **a credit card facilitates making purchases via telephone or over the network** (in Bezos col. 1, lines 41-42).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 61-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnett (6,336,099 hereinafter Barnett) in view of Bezos (5,715,399 hereinafter Bezos).

With respect to claim 61, Barnett teaches establishing electrical communication over the Internet between a service system plurality of remote users having personal computers (i.e. the online service provider 2 transmits product information to a response unit at a customer site)(Figures 1 and 9); receiving at the service system from a plurality of issuer systems instructions for issuing the redeemable coupons (Figure 1, items 14 and 16); receiving profile data at the service system input by the remote users over the Internet (i.e. the online service provider receives user data)(see figures 1 and 9); the service system permitting remote user access to offers for redeemable coupons upon the entry of profile data requested of the remote users by the service system (see figure 1); said offers being accessible over the Internet to selective users based on analysis of the profile data (see figures 1 and 9); storing coupon files in a data base, said coupon files containing information relating to redeemable coupons offered to and selected by the remote users (see Figure 1, item 11).

With respect to automatically redeeming coupons contained in said stored data base when the remote users make transaction using a credit card. Barnett teaches

allowing the users to redeem the stored coupons when making purchases electronically/automatically (see figure 1 and col. 11, lines 30-40). Barnett is silent as to the form of payment used to make the purchases. Bezos teaches a method and system for communicating a credit card number over a network. The customer/user makes an on-line purchase using one or more credit cards (col. 5, lines 24-38) . It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included using a credit card to make the purchases because **a credit card facilitates making purchases via telephone or over the network** (in Bezos col. 1, lines 41-42).

With respect to claims 62-63, Barnett further teaches that the coupon file is transmitted to said database via the service system using the Internet (i.e. the Online service provider sends the coupon request file to database 11 using the Internet (See Figures 1 and 10 and col. 13, lines 58-60).

Response to Arguments

7. With respect to the double patenting concerning U.S. Paten No. 5,761,648, the double patenting is sustained. Applicant has agreed to provide a terminal disclaimer therefore no further comment is necessary.

8. With respect to the obviousness-type double patenting rejection concerning application no, 09/484,290. It is noted that US patent application number 10/438,582 had been filed in favor of the 09/484,290 application. The instant claims as amended are not patentably distinct from the 10/438,582 application. New analysis of the claims as amended has been treated in the obviousness-type double patenting rejection

above. Following the procedure stated in MPEP 804, If the "provisional" double patenting rejections in both applications are the only rejections remaining in those applications, the examiner should then withdraw that rejection in one of the applications (e.g., the application with the earlier filing date) and permit the application to issue as a patent. The examiner should maintain the double patenting rejection in the other application as a "provisional" double patenting rejection which will be converted into a double patenting rejection when the one application issues as a patent. This is not the case in the present application because the claims were not only rejected under double patenting rejection but prior art was also applied to reject the claims. Therefore the obviousness-type double patenting rejection has been sustained.

9. With respect to Applicant's argument with respect to the newly added feature, of automatically redeeming coupons contained in said stored database when the remote users make transaction using a credit card. Barnett teaches allowing the users to redeem the stored coupons when making purchases electronically/automatically (see figure 1 and col. 11, lines 30-40). Barnett is silent as to the form of payment used to make the purchases. Bezos teaches a method and system for communicating a credit card number over a network. The customer/user makes on-line purchases using one or more credit cards (col. 5, lines 24-38). Bezos even recognizes that **a credit card facilitates making purchases via telephone or over the network** (in Bezos col. 1, lines 41-42).

10. In light of the above, it is the Examiner's position that Barnett in combination with Bezos teach the claimed limitations.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Point of contact

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9326.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

Raquel Alvarez
Examiner
Art Unit 3622

R.A.
12/16/03

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Merriam-Webster Online Dictionary

Thesaurus

8 entries found for **automatic**.
To select an entry, click on it.

automatic[1,adjective]
automatic[2,noun]
automated teller machine
automatic pilot
automatic writing
Browning automatic rifle
Go

Main Entry: **[1]au·to·mat·ic**
Pronunciation: `"o-t&-'ma-tik`
Function: *adjective*
Etymology: Greek *automatos* self-acting, from *aut-* + *-matos* (akin to Latin *ment-*, *mens* mind) -- more at MIND
1 a : largely or wholly involuntary; *especially* **:** REFLEX 5 <*automatic* blinking of the eyelids> **b :** acting or done spontaneously or unconsciously **c :** done or produced as if by machine **:** MECHANICAL <the answers were *automatic*>
2 : having a self-acting or self-regulating mechanism
3 *of a firearm* **:** using either gas pressure or force of recoil and mechanical spring action for repeatedly ejecting the empty cartridge shell, introducing a new cartridge, and firing it
synonym see SPONTANEOUS
- **au·to·mat·i·cal·ly** /`-ti-k(&-)lE`/ *adverb*
- **au·to·ma·tic·i·ty** /`-m&-'ti-s&-tE, -ma-`/ *noun*

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One entry found for **electronic**.

Main Entry: **elec·tron·ic**
Pronunciation: `i-"lek-'trä-nik`
Function: *adjective*
1 : of or relating to electrons
2 : of, relating to, or utilizing devices constructed or working by the methods or principles of electronics; *also* : implemented on or by means of a computer <*electronic* food stamps> <*electronic* banking>
3 a : generating musical tones by electronic means <an *electronic* organ> **b :** of, relating to, or being music that consists of sounds electronically generated or modified
4 : of, relating to, or being a medium (as television) by which information is transmitted electronically <*electronic* journalism>
- **elec·tron·i·cal·ly** `/-ni-k(&-)lE/` *adverb*

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One entry found for **automatic**.

Entry Word: **automatic**
Function: *adjective*
Text: **1**
Synonyms SPONTANEOUS, impulsive, instinctive, involuntary, unmeditated, unpremeditated, unprompted, will-less
Related Word prompt, quick, ready; accustomed, confirmed, habitual, habituated
2
Synonyms PERFUNCTORY, mechanical

Thesaurus Symbols